

### **REMARKS**

Claims 1-23 are presently pending. Claims 1-2, 7-8, 11-13, and 19-23 have been amended. Thus, claims 1-23 remain pending in the present application.

### **Claim Objections**

Claims 20 and 21 have been objected to because of the following informalities. Claim 20 has been objected to because it may not depend from future claim 21. Claim 21 has been objected to because it may not depend from itself.

Claims 20 and 21 have been amended to depend from claim 19. In view of these amendments, the Applicants believe this objection is deemed moot. Accordingly, the Applicants respectfully request that the Examiner withdraw these objections.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,752,881 to Inoue (“Inoue”). The Applicants respectfully request that the Examiner reconsider and withdraw this rejection in light of the following remarks.

### **Independent Claim 1**

According to the law of anticipation, “[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, **every element** of the claimed invention must be **identically shown** in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the . . . claim”. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Claim 1 of the present invention requires “an **extendable display** . . . having a first position in a field of view of a player and a second position out of the field of view of a player”. Claim 1 has been clarified to include “moving the extendable display in a first direction from the first position to the second position” and “moving the extendable display in a second direction from the second position to the first position”. Examples of extendable displays are shown in FIGs. 4, 6, 9-10, 12-13, and 15-17.

Inoue is directed towards a gaming machine forming compound symbols. Inoue, *inter alia*, col. 2, l. 35. The gaming machine of Inoue includes a rotatable inner reel disposed within a

rotatable outer reel, such that transparent symbols on the outer reel make portions of the inner reel visible to a player, thereby creating compound symbols. *Id.*, col. 1, ll. 9-10; col. 2, ll. 31-36.

Inoue does not disclose, teach, or suggest an extendable display, as required by the present invention. In support of the contrary assertion, the Examiner cites a portion of Inoue stating:

FIG. 11 illustrates a symbol display device having a belt construction. A symbol display device 90 has an endless outer belt 91 and an endless inner belt 93. The outer belt 91 has an opaque peripheral face 91a, on which plural kinds of symbols are arranged, these symbols including opaque border lines 92a and transparent portions 92b. The inner belt 93 has a peripheral face 93a on which plural kinds of patterned portions 94 are arranged in plural colors.

Inoue, col. 8, ll. 52-58. Nowhere in this cited portion, or in any other portion of Inoue, is an extendable display disclosed. The outer and inner belts of the Inoue's symbol display device are mounted on a pair of rollers rotatably supported on a fixed frame. *Id.* at col. 8, ll. 60-62, col. 9, ll. 1-2; FIG. 11. The cited portion of Inoue essentially describes a traditional mechanical reel structure where the reel rotates around a stationary device. Moreover, the display window of Inoue is fixed, and symbols are "adapted to be stopped in the display window" after every spin. See, *id.*, FIGs. 1 and 12; col. 6, ll. 36-40. The symbol display device of Inoue would, therefore, never be extendable.

Furthermore, Inoue does not disclose "moving the extendable display in a first direction from the first position to the second position" and "moving the extendable display in a second direction from the second position to the first position", as required by claim 1. The inner reel and the outer reel of Inoue move in only one direction. Therefore, this element of claim 1 is also not disclosed in Inoue.

Thus, the Applicants respectfully submit that claim 1 is allowable over Inoue because Inoue does not disclose every element of the claim. Applicants respectfully submit that claims 2-8, which depend from claim 1, are allowable for at least the same reasons.

### **Claim 3**

The Examiner has rejected claim 3 as being anticipated by Inoue because "Inoue discloses a gaming machine . . . wherein the first position is behind an obstruction." Office Action, p. 4. In support of this assertion, the Examiner has cited the following portion of Inoue: "In either [a reel type or a video] type [of gaming machine], symbols stopped in a display window after the end of symbol movement are checked. The stopped combination of the symbols on a winning line is

determined to be a win or a loss.” Inoue, col. 1, ll. 24-28. The cited portion of Inoue merely describes how a symbol combination is evaluated in a traditional gaming machine. Thus, the Applicants respectfully submit that the Examiner mischaracterizes this portion of Inoue as being directed to a gaming machine “where a viewing window is not large enough to show all indicia that would have been visible to a player without a viewing window present.” Office Action, p. 4. In fact, the Applicants submit that it is not the size of the viewing window that necessarily limits the amount of indicia that are visible to a player in Inoue; rather, it may be the curvature of the reels, in which case the indicia is considered to be on – not behind – an obstruction. *See, e.g.*, Inoue, FIGs. 1 and 12.

Thus, for at least these reasons as well as for the reasons set forth above with respect to claim 1, the Applicants submit that claim 3 is allowable over Inoue.

#### **Independent Claim 8**

The Applicants respectfully submit that Inoue does not disclose all of the limitations of claim 8 including an “extendable display” and “a first position behind an obstruction” as discussed above with respect to claims 1 and 3, respectively. Additionally, the Applicants submit that Inoue does not disclose “a plurality of extendable displays,” as further required by claim 8. The cited portion of Inoue discloses “a symbol display device” having two layers including an inner belt and an outer belt. Inoue, col. 8, ll. 52-59. Thus, even accepting that the Examiner assertion that all of the other elements of claim 8 are disclosed by Inoue (which the Applicants submit are lacking), Inoue does not disclose a plurality of extendable displays.

Thus, for these reasons as well as for the reasons set forth above with respect to claims 1 and 3, the Applicants submit that claim 8 is allowable over Inoue. The Applicants further submit that claims 9-12, which depend from claim 8, are allowable for at least the same reasons.

#### **Independent Claim 13**

Claim 13 requires “locating an extendable display in the game display in a first position” and “moving the extendable display in a first direction to a second position”. Claim 13 has further been clarified to require “moving the extendable display in a second direction to return the extendable display to the first position.” As discussed above with respect to claim 1, Inoue does not disclose an extendable display, let alone the act of locating an extendable display or extending the extendable

display. Furthermore, as discussed above with respect to claim 1, the inner reel and the outer reel of Inoue move in only one direction. Thus, the “first direction” and “second direction” limitations of present claim 13 are not disclosed in Inoue.

The act of “locating an extendable display in the game display in a first position” has been described in one example of the present specification as follows: “The momentary lag between finding the deployed extendable display and recognizing the game outcome increases the player’s anticipation, and creates excitement through the sudden and random appearance of the extendable display.” Present Spec., p. 5, ll. 21-24. It is unclear how this limitation is anticipated by the portion of Inoue that has been relied upon to make the rejection, which states “In FIG. 1, a slot machine 2 has three display windows 3, 4, and 5. Behind the display windows 3-5 are disposed symbol display devices of the driven reel type”. In fact, the cited portion of Inoue effectively states that both the display windows and the symbol display devices are always located in the same position. Thus, why would the act of “locating” the display be a feature of Inoue?

Thus, for at least these reasons as well as for the reasons provided above with respect to claim 1, the Applicants respectfully submit that claim 13 and its dependent claims 14-18 are allowable over Inoue.

#### **Claim 16**

The Applicants respectfully submit that claim 16 is allowable for at least the reasons set forth above with respect to claim 3 and claim 13.

#### **Independent Claim 19**

The Applicants respectfully submit that claim 19 and its dependent claims 20-22 are allowable for at least the same reasons set forth above with respect to claim 3, claim 8, and claim 13.

#### **Independent Claim 23**

The Applicants submit that claim 23 is allowable for at least the same reasons as set forth above with respect to claim 1. Additionally, the Applicants submit that the limitation of “a second position partially in the field of view of a player”, required by claim 23, is not disclosed in Inoue. In support of the assertion that Inoue discloses this limitation, the Examiner cites FIG. 7, element 20 of Inoue. Office Action, p. 4. FIG. 7, however, is a mere explanatory view and is, therefore, not

intended to represent an actual view of a display. Inoue, col. 3, l. 44. It should be noted that none of FIG. 1, a perspective view of a slot machine, FIG. 12, a front elevational view of a slot machine, or the written disclosure of Inoue disclose “a second position partially in the field of view of a player”. Accordingly, the limitation “the central processing unit further adapted to signal the drive mechanism to translate the extendable display from the second to the third position” is also not anticipated.

Thus, the Applicants respectfully request that the rejection of claim 23 be withdrawn.

### **Claim Rejections – 35 U.S.C. § 103**

#### **Claim 12**

Claim 12 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Inoue in view of U.S. Patent No. 3,913,922 to Richards et al. (“Richards”).

Claim 12 requires a drive mechanism comprising “a plurality of solenoid valves, each solenoid valve being connected to one of the plurality of extendable displays, each of the plurality of solenoid valves adapted to linearly translate the extendable display.”

The Applicants respectfully submit that a *prima facie* case of obviousness has not been made for several reasons. First and foremost, the proposed combination fails to teach all of the elements of claim 12. Second, the proposed combination fails because there is no motivation, suggestion, or teaching to combine Inoue and Richards. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). In short, the Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to modify Inoue’s stepper motor based method of rotating a belt display to incorporate Richards’ solenoid valve for linearly translating a belt display.

The Inoue-Richards combination does not disclose all of the elements of claim 12. First, Inoue, Richards, or a combination thereof does not disclose an “extendable display,” as described above with respect to claim 1. Additionally, Richards does not disclose a “plurality of solenoid valves adapted to linearly translate the extendable display”, as required by claim 12. Rather, Richards discloses using a solenoid valve to disengage a brake by pivoting a bell crank lever. Richards, col. 3, ll. 3-12. The energized solenoid causes the bell crank lever to pivot and remove the brake applied to the reel. *Id.* The solenoid valve of Richards, therefore, does not linearly translate any part of the display.

Furthermore, one would not be motivated to modify Inoue's compound symbol device to incorporate the position sensing device of Richards. Nor would one would be motivated to look to a reference (i.e., Richards) directed to providing a means for simplifying and economizing on the electrical wiring between the reel position-sensing apparatus and the translating equipment of gaming machines (Richards, col. 1, ll. 31-35) to modify a reference (i.e., Inoue) directed to providing a symbol display device for a gaming machine in which games are easy for players to grasp, have considerable eventfulness, and provide continuous enjoyment (Inoue, col. 2, ll. 4-10). Furthermore, because Inoue already teaches its own type of means for rotating reels for a gaming machine (Inoue, col. 5, ll. 16-24), why would the skilled artisan be motivated to add the solenoid feature of Richards, as suggested by the Examiner? It is also unclear how "modif[ying] the stepper motor based method of linearly translating an extendable display . . . with the method of linearly translating plural reels using solenoid valves" would result in "more accurate control of a reel game". Office Action, p. 7.

For at least the foregoing reasons, the Applicants respectfully submit that claim 12 is patentable over Inoue in view of Richards. Therefore, the Applicants respectfully request that the rejection of claim 12 be withdrawn.

### **CONCLUSION**

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. The Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is the Applicants' belief that no further fees are due at this time. However, should the Applicants be mistaken, the Commissioner is authorized to charge any fees that may be required (except for payment of the issue fee) to Jenkins & Gilchrist, P.C., Deposit Account No. 10-0447, Order No. 47079-00228USPT. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

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